

### REMARKS

Claims 1-33 were pending. The applicants amend claim 1 and cancel claims 2 and 3. The applicants present claims 1 and 4-33 for examination in view of the remarks below.

Claims 1-11, 15, and 20-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,368,045 ("Clement") in view of U.S. Pat. No. 5,197,484 ("Kornberg"), and further in view of U.S. Pat. No. 5,467,684 ("Sher"). Claims 12-14, 16-19, 31-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Clement, Kornberg, and Sher in further view of U.S. Pat. No. 5,921,943 ("Kass"); U.S. Pat. 5,394,887 ("Haaga"); U.S. Pat. No. 6,331,166 ("Burbank"); or U.S. Pat. No. 5,649,547 ("Ritchart").

Claim 1, as amended, and claim 22 recite

**a stylet block, the stylet block attached to a proximal end of the stylet and mounted inside the housing, the stylet block comprising:**

**a first part inside the housing, the first part being moveable between a third extended position and a third retracted position; and**

**a second part attached to the proximal end of the stylet, the second part being rotatably engaged and in contact with the first part and being able to rotate relative to an axis of the stylet.**

The features added to claim 1 were previously recited by claims 2 and 3. Claim 15 recites

**moving a stylet and a stylet block from a first position to a second position, the stylet block having an axially moveable first part and a second part attached to the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet;**

**simultaneously causing rotation of the stylet along an axis of the stylet by contact between the second part of the stylet block and a housing of the medical instrument[.]**

The pending office action does not assert that any of the cited references disclose a stylet block with a first part moveable between an extended position and a retracted position; and a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet. Accordingly, the examiner has not established a prima facie case of obviousness of independent claims 1, 15, and 22 and the applicants request that the rejections of claims 1 and 4-33 under 35 U.S.C. 103(a) as being unpatentable over Clement, Kornberg, and Sher, in combination or further view of Kass; Haaga; Burbank; or Ritchart be withdrawn.

In the interest of expediting prosecution, the applicants further address statements the examiner has previously made regarding the stylet block.

The examiner conceded that Clement does not disclose a medical device with a stylet configured to rotate when moved from a retracted position to an extended position much less a medical device with a stylet block as claimed by the applicants.<sup>1</sup> Neither Kornberg nor Sher disclose a medical device with a stylet block as claimed by the applicants.

Kornberg discloses a cannula 54 disposed within but not attached to a driving member 91.<sup>2</sup> In operation, a driving pin 94, secured to cannula 54, exits drive channel 92 defined in driving member 91 such that the driving pin is free to rotate.<sup>3</sup> Thus, cannula 54 is not attached to driving member 91.

Claim 4 further specifies that

**the housing comprises a semi-cylindrical portion defining a track configured to engage with the second part.**

Kornberg discloses a track 158 which engages driving pin 94.<sup>4</sup> However, track 158 does not engage driving member 91 (characterized in the Office Action as the "second part").

Claim 5 further specifies that

**the second part comprises:  
a projection in contact with a track associated with the housing, the projection and track capable of cooperating to axially rotate the second part and the attached stylet when the stylet is moved between the first extended position and the first retracted position.**

As noted above, driving pin 94 is discrete and separate from driving member 91. Thus, driving member 91 does not comprise driving pin 94.

The examiner previously responded that

**In response the Applicant's argument that Kornberg fails to teach a second part as claimed, the Examiner respectfully traverses. Consistent with the Applicant's very own disclosure and partly due to a lack of better enumeration, the numeral 91 has been used in the Office action generically to represent the entire subassembly at the proximal end of the cannula 54 as better depicted in figure 17, which from the Examiner's Office action has been called the second part (see also the Office action**

---

<sup>1</sup> See Office Action dated November 4, 2008, p. 2.

<sup>2</sup> See Kornberg, col. 9, line 35 – col. 10, line 59 and col. 14, lines 26-34.

<sup>3</sup> See id., col. 14, lines 35-44.

<sup>4</sup> See id., FIG. 12 and col. 14, lines 35-44.

**dated September 4, 2007). As such, the office action in part contends that the second part includes both elements 55 and 91 of Kornberg. As such, at page 6, the Office action parsingly recite that the second part includes a projection in contact with a track. Moreover, the Applicant's response appears to be a partial response to the rejection at hand since the Examiner has proposed a first reference (i.e. Clement et al.), which clearly shows a first and the second part. The rejection under Kornberg apply primarily to show how the second part of Clement et al. can be modified while keeping the rest of the device substantially intact.<sup>5</sup>**

This argument is inconsistent with the rejection that it is intended to support and serves to emphasize the differences between the structure claimed by the applicants and the teachings of Kornberg. The examiner had previously asserted that Kornberg described a "second part 91 rotatably engaged and in contact with a first part 55."<sup>6</sup> By redefining the second part to include "the entire subassembly at the proximal end of cannula 54" including cannula section 55, driving member 91, and driving pin 94, there is no longer, by the examiner's own definitions, a first part rotatably engaged to the second part. Rather, the entire subassembly at the proximal end of cannula 54 is directly attached to the cannula and is not rotatably engaged and in contact with "a **first part inside the housing, the first part being moveable between a third extended position and a third retracted position**" as claimed by the applicants.

The applicants also note that, rather than asserting that the stylet block "clearly shows a first and second part,"<sup>7</sup> the examiner previously asserted that the

**In regards to claims 3 & 22, Clement et al. discloses a medical instrument wherein the stylet block 36 comprises: a first part inside the housing 8, the first part being moveable between an extended position and a retracted position (see fig. 2).<sup>8</sup>**

The applicants did not respond to the issue of whether Clement's stylet block has first and second parts because this issue had not previously been raised. However, modifying Clement's stylet block with the mechanism described by Kornberg would not result in the claimed structure for at least the reasons discussed above. Thus, the issue of whether or not Clement's stylet block has first and second parts is a moot point.

---

<sup>5</sup> Advisory action mailed May 27, 2008, p. 2.

<sup>6</sup> Office Action mailed February 25, 2008, p. 4.

<sup>7</sup> Advisory action mailed May 27, 2008, p. 2.

<sup>8</sup> Office Action mailed February 25, 2008, p. 3

Sher also does not disclose a stylet block with a first part moveable between an extended position and a retracted position; and a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet. In contrast, Sher discloses a piston 3 with a wave-shaped groove 8 defined in its outer surface which engages guide members 9 extending inward from a housing or, in an alternate embodiment, a piston 3 with guide members 9 extending outward from the piston to a wave-shaped groove defined in the housing.

For at least these reasons, none of the cited references has been shown to disclose or make obvious a stylet block with a first part moveable between an extended position and a retracted position; and a second part attached to the proximal end of the stylet, the second part being rotatably engaged with the first part and being able to rotate relative to an axis of the stylet. Accordingly, Clement, Kornberg, and Sher, in combination or further view of Kass; Haaga; Burbank; or Ritchart do not provide the basis for a prima facie case of obviousness of the pending claims.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicants have (a) addressed certain comments of the examiner does not mean that the applicants concede other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicants concede any of the examiner's positions with respect to that claim or other claims.

Applicant : Paul DiCarlo et al.  
Serial No. : 10/728,248  
Filed : December 4, 2003  
Page : 12 of 12

Attorney's Docket No.: 01194-0824001 / 03-088

No fees are believed to be due . Please apply any other charges or credits to Deposit  
Account No. 06-1050, referencing Attorney Docket No. 01194-824001.

Respectfully submitted,

Date: January 27, 2009

/Sean M. Dean/  
Sean M. Dean, Ph.D., J.D.  
Reg. No. 46,656

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (877) 769-7945  
22064780.doc